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Date: September 27, 2005

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Our Docket No. YU 182

Client/Matter No: 078245-00045

Your Docket No.

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MESSAGE:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter M. Glazer

Serial No: 09/978,333

Art Unit: 1634

Filed: October 15, 2001

Examiner: Carla Myers

For: *TRIPLE-HELIX FORMING OLIGONUCLEOTIDES FOR TARGETED
MUTAGENESIS*

Attachments:

Transmittal Form PTO/SB/21;

Fee Transmittal PTO/SB/17;

Submission of Decision on Appeal; and

Decision on Appeal

{45058774.1}

SEP 27 2005

PTO/SB/21 (09-04)

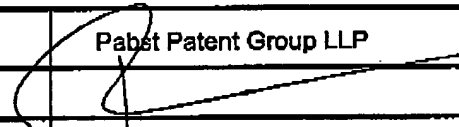
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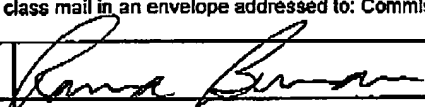
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/978,333
	Filing Date	October 15, 2001
	First Named Inventor	Peter M. Glazer
	Art Unit	1634
	Examiner Name	Carla Myers
Total Number of Pages in This Submission	Attorney Docket Number	YU 132

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Decision on Appeal
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Pabst Patent Group LLP		
Signature			
Printed name	Patricia L. Pabst		
Date	September 27, 2005	Reg. No.	31,284

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Typed or printed name	Ronna Berman	Date	September 27, 2005

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NO. 5575 P. 3

PTO/SB/17 (12-04)

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FEE TRANSMITTAL **For FY 2005**

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 0.00

Complete if Known

Application Number 09/978,333
Filing Date October 15, 2001
First Named Inventor Peter M. Glazer
Examiner Name Carla Myers
Art Unit 1634
Attorney Docket No. YU 132

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 50-3129 Deposit Account Name: Pabst Patent Group LLP

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims 17 - 25 or HP = Extra Claims x Fee (\$) 0.00 Fee Paid (\$) 0.00 Multiple Dependent Claims Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20

Indep. Claims 1 - 3 or HP = Extra Claims 0 x Fee (\$) 0.00 Fee Paid (\$) 0.00

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)

- 100 = / 50 = (round up to a whole number) x =

4. OTHER FEE(\$)

Non-English Specification, \$130 fee (no small entity discount)

Other:

SUBMITTED BY

Signature _____ Registration No. 31,284 Telephone (404) 879-2151
Name (Print/Type) Patrea L. Pabst Date September 27, 2005

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Peter M. Glazer

Serial No.: 09/978,333

Art Unit: 1634

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Filed: October 15, 2001

Examiner: Carla Myers

For: *TRIPLE-HELIX FORMING OLIGONUCLEOTIDES FOR TARGETED
MUTAGENESIS*Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**SUBMISSION OF DECISION ON APPEAL IN U.S.S.N. 09/783,338**

Sir:

Further to the Appeal Brief filed September 21, 2005, Appellant submits a copy of the Decision of Appeal in U.S.S.N. 09/783,338 reversing the Examiner's rejection of the claims for lack of enablement under 35 U.S.C. § 112, first paragraph, for consideration by the Examiner of the above-referenced application. Appellant noted in the Appeal Brief filed September 21, 2005 that the appeal in U.S.S.N. 09/783,338 addresses similar issues addressed in the Appeal Brief of the above-referenced application.

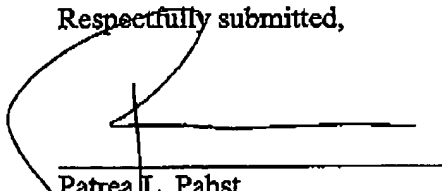
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YU 132
078245/00045

U.S.S.N.: 09/978,333
Filed: October 15, 2001

It is believed that no fee is required with this submission. However, should a fee be required, the Commissioner is hereby authorized to charge the fee to Deposit Account No. 50-3129.

Respectfully submitted,



Patrea L. Pabst
Reg. No. 31,284

Date: September 27, 2005

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YU 132
078245/00045

SEP 27 2005

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCESEx parte PETER M. GLAZER and PAMELA A. HAVRE

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Appeal No. 2005-0733
Application No. 09/783,338¹

SEP 26 2005

HEARD: July 14, 2005

PATENT DEPT.

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SEP 22 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCESBefore SCHEINER, ADAMS and MILLS, Administrative Patent Judges.SCHEINER, Administrative Patent Judge.DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 6-14 (the only claims remaining in the application) under the first paragraph of 35 U.S.C. § 112. There is no dispute that "the central issue on Appeal is whether the claims, as they relate to [an] in vivo [method], lack enablement." Reply Brief, page 1.

The present application is a continuation of U.S.S.N. 08/083,088.² The claims in the parent application were much the same as the claims in the present application (see the comparison below), and were rejected on the same basis. Following an appeal of the rejection in that case (Appeal No. 1997-2520, opinion dated February 28, 2001), the board agreed that the examiner had established a reasonable basis for questioning the enablement of the claims, and affirmed the examiner's rejection.

¹ Application for patent filed February 14, 2001.

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Application No. 09/783,338

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According to appellants, "[e]vidence showing in vivo as well as additional evidence of in vitro efficacy was obtained after filing of the appeal [in the parent case], but could not be considered in [that] appeal. The present application was filed so that such evidence could be considered (submitted in the form of a Declaration under [37 CFR § 1.132])." Brief, page 2.

THE CLAIMED SUBJECT MATTER

Claim 6 is representative of the subject matter on appeal and reads as follows:

6. A method for site-directed mutagenesis of a nucleic-acid molecule comprising the steps of:

- a) hybridizing a mutagenic oligonucleotide to a target region of a double-stranded nucleic acid molecule, wherein the mutagenic oligonucleotide comprises a mutagen incorporated into a single-stranded nucleic acid that forms a triple-stranded nucleic acid molecule with the target region; and
- b) mutating the double-stranded nucleic acid molecule.

The corresponding claim in U.S.S.N. 08/083,088 is as follows (differences emphasized):

6. A method for site-directed mutagenesis of a nucleic acid molecule **consisting** of steps of:

- a) hybridizing a mutagenic oligonucleotide to a target region of a double-stranded nucleic acid molecule **in a cell**, wherein the mutagenic oligonucleotide comprises a mutagen incorporated into a single-stranded nucleic acid that forms a triple-stranded nucleic acid molecule with the target region; and
- b) mutating the double-stranded nucleic acid molecule.

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Application No. 09/783,338

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DISCUSSION

In deciding the appeal in U.S.S.N. 08/083,088 (Appeal No. 1997-2520), the parent of the present application, the board considered the examiner's thorough analysis of appellants' disclosure under the so-called Wands factors,³ and concluded that "the totality of the evidence presented by the examiner and appellants weigh[ed] in favor of finding lack of enablement of the claimed invention" (page 13 of the opinion in Appeal No. 1997-2520). In the present case, however, appellants have submitted "[e]vidence of reduction to practice in intact animals . . . in the form of a Declaration . . . to prove the truth of the statements in the application" (Brief, page 7). As the examiner explains, "the Declaration by Dr. Glazer⁴ . . . represents the only new evidence in this application" (Answer, page 10), so we will focus our discussion on whether or not the Declaration is adequate to address the examiner's concerns and to rebut the examiner's rejection.

In a nutshell, the examiner's concerns with respect to the in vivo aspects of the claimed invention involve "issues of [oligonucleotide] delivery, penetration," and "triplex formation" (Answer, page 7) in an intact animal. The examiner acknowledges that "[t]he specification [demonstrates] site specific, targeted mutagenesis . . . in an in vitro method" and "in an ex vivo type method" (Id., page 5), but argues that "there is no

³ Factors to be considered in determining whether a disclosure is unenabling because it would require undue experimentation to practice the invention have been summarized by the board in Ex parte Forman [230 USPQ 546, 547 (BdPatAppInt 1986)]. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims (footnote omitted).

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

⁴ Submitted December 3, 2002.

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Application No. 09/783,338

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correlation between the entry of the oligonucleotide-mutagen complex in isolated cells in an *ex vivo* method and in *vivo* applications where entry into an animal is required" (*id.*), largely because "the precise role of nucleases, other intracellular enzymes and proteins on the stability of [] ribozymes, . . . [mechanisms] by which oligonucleotides penetrate cellular membranes and distribute in cells, [] non-sequence-specific interactions[,] . . . metabolism of antisense drugs . . . and cellular parameters such as cell type, cell cycle phase and differentiation stage" (*id.*, page 6) are poorly understood and unpredictable.

In his declaration, Dr. Glazer describes the protocols and results of experiments in which mice were given intraperitoneal injections of a triplex-forming oligonucleotide (TFO) designed to bind to a predetermined site on the *supFG1* gene. See section 12, pages 6-14 of the Declaration. The examiner does not dispute Dr. Glazer's assertion that the mouse experiments described in the Declaration "demonstrate that site-specific, TFO-directed genome modification can be accomplished in intact animals" (Declaration, page 7). Rather, the examiner argues that the *in vivo* experiments described in the Declaration are not commensurate in scope with the claimed invention because the mutagenic oligonucleotide used in the mouse experiments differs from the oligonucleotide used in the specification's *in vitro* and *ex vivo* examples in that it does not have a discrete mutagen associated with it. See pages 11 and 12 of the Answer.

As explained by Dr. Glazer, however, *in vitro* experiments established that targeted mutagenesis was seen with and without psoralen⁵ conjugation, "suggesting a substantial triplex-mediated process of mutagenesis" (Declaration, page 7), and appellants argue that "there has been no evidence provided by the examiner that the

⁵ Psoralen is a known mutagen.

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Application No. 09/783,338

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In vivo evidence in the Declaration would not be predictive of an oligonucleotide which further included a small molecule mutagen such as a psoralen" (Reply Brief, page 5). In any case, it does not appear that the examiner has questioned the ability of an attached mutagen to cause a mutation in a double-stranded nucleic acid molecule, once delivered to a cell.

In our opinion, the examiner has not explained why the mouse experiments described by Dr. Glazer are not relevant to the examiner's stated concerns: "Issues of [oligonucleotide] delivery, penetration," and "triplex formation" (Answer, page 7). On this record we see no reason to dispute appellants' assertion that the experiments described in the Declaration demonstrate "the ability of the oligonucleotide to specifically bind the target gene[;] formation of a stable complex between the oligonucleotide and the target gene[;] uptake of the oligonucleotide by the cell[;] and [] solubility of the nucleotide in the cell" (Brief, page 12).

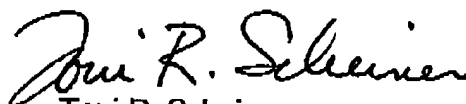
Finally, we note the examiner's assertion that "simply correcting a few cells of [an] arbitrary mutation created in the mouse is not enough for a patentable use" "since no therapeutic effect has been shown for any of the oligonucleotides" (Answer, page 11) and in any case, "[t]he mutations must be corrected in sufficient amounts to yield some benefit or there is no patentable use for the correction method" (Id., pages 11-12). Nevertheless, the claims have not been rejected as lacking utility, and we perceive no requirement in the claims that the method have any therapeutic effect.

Appeal No. 2005-0733
Application No. 09/783,338

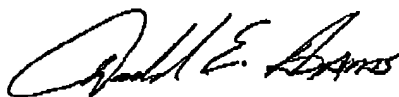
Page 6

In our view, the Declaration of Dr. Glazer provides evidence sufficient to rebut the examiner's initial basis for questioning the enablement of the claimed invention. Accordingly, the rejection of claims 6-14 under the first paragraph of 35 U.S.C. § 112 is reversed.

REVERSED



Toni R. Scheiner
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Demetra J. Mills
Administrative Patent Judge

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) APPEALS AND
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Appeal No. 2005-0733
Application No. 09/783,338

Page 7

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